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PATENT
02931-P0023A WWW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	Karl Storz et al.
U.S. Patent No. 6,042,593	Issue Date: March 28, 2000
Title of Patent:	Shaving Or Cutting Instrument

09/077180

DECLARATION OF DR. WINFRIED FUGMANN IN SUPPORT OF PETITION
FOR RETROACTIVE FOREIGN FILING LICENSE UNDER 37 C.F.R. 5.25

I, Winfried Fugmann, hereby declare and state as follows:

1. I am the Head of the Patent Department at Karl Storz GmbH & Co. KG and have responsibility for patent matters at Storz Endoskop GmbH and its successor, Storz Endoskop Produktions GmbH. I make this declaration in support of the Petition For Retroactive Foreign Filing License Pursuant To 37 C.F.R. 5.25, which was submitted on August 26, 2004.
2. Storz Endoskop GmbH, the assignee of the patent in question, and its successor, Storz Endoskop Produktions GmbH, are part of the multinational Karl Storz group (hereinafter "Storz"), based in Germany, with facilities in various countries, including Germany, Switzerland and the United States.

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APR 20 2005
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APR 26 2005

GROUP 3600

Page 2
U.S. Patent No. 6,042,593
Declaration of Dr. Winfried Fugmann

3. In the present case, the three inventors of the subject matter to which the patent in question is directed were Karl Storz in Germany, who is now deceased; Pavel Novak in Switzerland, who is no longer affiliated with Storz; and Simon Solingen in the United States.

4. At the time of the proscribed filings, there was no in-house attorney with responsibility for patent matters at Storz.

5. To the best of my knowledge, all at Storz believed that the subject inventions had been made in Germany until recently, when counsel in the United States informed me that the inventions more likely were made in the United States than in Germany.

6. The present petition for retroactive foreign filing license was filed promptly after I learned about the proscribed facts.

7. The proscribed filings in the present case were made, to the best of my knowledge, through error and without deceptive intent because of the erroneous identification of Germany as the country where the inventions had been made.

8. It has been and is Storz's long-standing policy to obtain all necessary foreign filing licenses.

Page 3

U.S. Patent No. 6,042,593

Declaration of Dr. Winfried Fugmann

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

April 8, 2005

Date

W. Fugmann

Dr. Winfried Fugmann



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APR 26 2005

GROUP 3600

**DECLARATION OF SIMON SOLINGEN IN SUPPORT OF PETITION
FOR RETROACTIVE FOREIGN FILING LICENSE UNDER 37 C.F.R. 5.25**

I, Simon Solingen, hereby declare and state as follows:

1. I am one of the inventors of the inventions of United States Patent No. 6,042,593 ("the '593 patent") and of the relevant German applications and PCT application that preceded the '593 patent. I make this declaration in support of the Petition For Retroactive Foreign Filing License Pursuant To 37 C.F.R. 5.25, which was submitted on August 26, 2004.
2. I presently reside in the United States and I resided in the United States when the application leading to the '593 patent was filed and when the relevant German and PCT applications were filed.
3. I did not know at the time of filing of any of the above applications that it was necessary either to file first an application in the United States on the subject inventions or to obtain a foreign filing license before filing an application outside of the United States.

Page 2
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09 MARCH 2005
Date



Simon Solingen

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ssjr.com

May 16, 2005

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JLR

DELIVER TO
Examiner Ian J. Lobo

NO. OF PAGES

11

FAX NUMBER
571-273-6974

FROM
Wesley W. Whitmyer, Jr.

Re: Inventors: Karl Storz, et al.
U.S. Patent No. 6,042,593
Issue Date: March 28, 2000
Serial No. 09/077,180
Shaving Or Cutting Instrument
SSJR File 02931-P0023A

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New Haven (203) 562 0400 ☎

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Inventors	Karl Storz <i>et al.</i>
U.S. Patent No. 6,042,593	Issue Date: March 28, 2000
Serial No. 09/077,180	Filed: July 16, 1998
Title of Patent:	Shaving Or Cutting Instrument

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

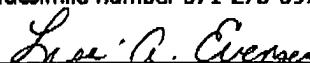
**CORRESPONDENCE RESUBMITTING RESPONSE AND
TWO DECLARATIONS**

Pursuant to a conversation today with Examiner Ian J. Lobo, submitted herewith are the following documents originally submitted on April 11, 2005:

1. Response to Non-Final Decision Regarding Petition For Retroactive Foreign Filing License Pursuant to 37 C.F.R. 5.25;
2. Declaration of Simon Solingen In Support of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25; and

Facsimile Certificate: I hereby certify that this correspondence is today being sent via facsimile addressed to: Examiner Ian J. Lobo, facsimile number 571-273-6974.

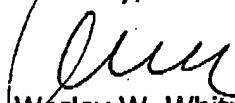
May 16, 2005


Lisa A. Evensen

U.S. Patent No. 6,042,593
Correspondence Resubmitting Response and Two Declarations
Page 2

3. Declaration of Dr. Winfried Fugmann In Support of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25.

Sincerely,



Wesley W. Whitmyer, Jr.
wwwjr@ssjr.com

Case No. 02931-P0023A WWW/ae

Applicants: Karl Storz (deceased), et al.

SN: 09/077,180 Filed 1998/07/16 Group 3731
 U.S. Patent No. 6,042,593 Issued: March 28, 2000
 For: Shaving Or Cutting Instrument

Receipt is hereby acknowledged of Response To Non-Final Decision Regarding Petition For Retroactive Foreign Filing License Pursuant To 37 C.F.R. 5.25, Declaration Of Simon Solingen In Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25 and Declaration Of Dr. Winfried Fugmann In Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25.

Mailed April 11, 2005

Commissioner
for Patents

Case No. 02931-P0023A WWW/ae

Applicants: Karl Storz (deceased), et al.

SN: 09/077,180 Filed 1998/07/16 Group 3731
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NON-FINAL DECISION REGARDING PETITION FOR
RETROACTIVE FOREIGN FILING LICENSE PURSUANT TO 37 C.F.R. 5.25

Dear Sir:

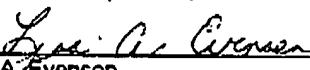
In response to the non-final decision of the Examiner mailed February 10, 2005, patentee, through its undersigned attorneys, is submitting herewith:

1. Declaration Of Simon Solingen In Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25; and
2. Declaration Of Dr. Winfried Fugmann In Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25.

These declarations are being submitted to further ensure that the requirements of 37 C.F.R. 5.25 are met. Together with Patentee's prior submissions in support of its petition, the accompanying declarations evidence that it was through error and without deceptive intent that the subject matter of the above-captioned

Mailing Certificate: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as *First Class Mail* in an envelope addressed to: Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450.

April 11, 2005


Lisa A. Evensen

Page 2
U.S. Patent No. 6,042,593
Response to Non-Final Decision on
Petition for Retroactive Foreign Filing License

patent was foreign filed before issuance of a foreign filing license by the United States Patent and Trademark Office.

Patentee believes that all requirements for granting a retroactive foreign filing license to Patentee have been met. Patentee respectfully requests that its petition for retroactive foreign filing license be granted.

Respectfully submitted,



Wesley W. Whitmyer, Jr., Registration No. 33,558
Attorney for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

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April 8, 2005

Date

W. Fugmann
Dr. Winfried Fugmann

TOTAL P.05